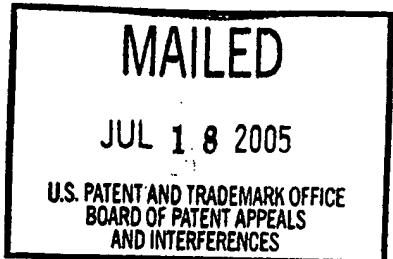


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte ALFRED GLANZMANN



Appeal No. 2005-0529
Application No. 09/579,901

ON BRIEF

Before FRANKFORT, NASE, and BAHR, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's non-final rejection (mailed December 11, 2003) of claims 1, 3, 4, 6 to 8, 12 and 15 to 17, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a transport disc for an opening device of a printed sheet feeder, wherein such a transport disc is arranged on one or both opening drums of the opening device and has at its circumference an outer elastic support. An individual printed sheet can be clamped for its transport to a transport device between the elastic support and the disc of another opening drum (specification, p. 1). A copy of the dependent claims under appeal is set forth in the appendix to the appellant's brief.

Claim 1, the only independent claim on appeal, reads as follows:

A transport disc for an opening device of a printed sheet feeder, the transport disc configured to be arranged on a first opening drum of the opening device, the transport disc comprising:

at least one outer elastic support, wherein the outer elastic support is configured to cooperate with a securing disc of a second opening drum of the opening device to clamp an individual printed sheet between the outer elastic support and the securing disc for transporting the individual printed sheet to a transport device,

wherein the outer elastic support is a rubber-elastic segment body extending in a circumferential direction of the transport disc, and

wherein the rubber-elastic segment body is comprised of an outer bearing layer and a compensation area positioned radially inwardly underneath the outer bearing layer, wherein the compensation area is radially yielding and supports the outer bearing layer, the compensation area being more elastic in the radial direction than the outer bearing layer, the compensation area having a plurality of stays each having a first end connected to the outer bearing layer and each having a second end positioned radially inwardly of the respective first end, the stays being formed as ledges or lamellas, the stays being positioned at a slant to a radial line extending in a radial direction from the first end to a center of the transport disc, respectively.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Nelson et al. (Nelson)	3,371,924	Mar. 5, 1968
Tebbe et al. (Tebbe)	5,048,809	Sep. 17, 1991
Koren ¹	EP 0 663 363 A1	July 19, 1995

Claims 1, 3, 4, 8, 12 and 15 to 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Nelson in view of Koren.

Claims 6 and 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Nelson in view of Koren and Tebbe.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (mailed June 1, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief (filed March 25, 2004) and reply brief (filed August 3, 2004) for the appellant's arguments thereagainst.

¹ In determining the teachings of Koren, we will rely on the translation of record (dated May 2004) provided by the USPTO.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1, 3, 4, 6 to 8, 12 and 15 to 17 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein).

In the rejection of claim 1 (answer, pp. 3-4), the examiner (1) found that Nelson discloses the claimed transport disc except that Nelson does not disclose that the outer elastic support (i.e., Nelson's sponge strips 30c) is comprised of an outer bearing layer and a compensation area positioned radially inwardly underneath the outer bearing layer, wherein the compensation area is radially yielding and supports the outer bearing layer, the compensation area being more elastic in the radial direction than the outer bearing layer, the compensation area having a plurality of stays each having a first end connected to the outer bearing layer and each having a second end positioned radially inwardly of the respective first end, the stays being formed as ledges or lamellas, the

stays being positioned at a slant to a radial line extending in a radial direction from the first end to a center of the transport disc, respectively; (2) found that Koren discloses a roller having an outer bearing layer as claimed; and (3) concluded that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Nelson by utilizing the outer elastic support disclosed by Koren for the purpose of controlling the position of sheets by spreading them widthwise.

In our view, the applied prior art does not have any motivation, suggestion or teaching that would have made it obvious at the time the invention was made to a person having ordinary skill in the art to have modified Nelson's sponge strips 30c to have a compensation area as set forth in claim 1. While the roller of Koren does have such a compensation area, that roller is used for guiding web-like materials, not folded sheets, and as such there is no incentive from the teachings of the references to have modified Nelson's folded sheet transport roller 30 so as to arrive at the claimed subject matter. The only suggestion for modifying Nelson in the manner proposed by the examiner to meet the above-noted limitations stems from impermissible hindsight knowledge derived from the appellant's own disclosure.

For the reasons set forth above, the decision of the examiner to reject claim 1, and claims 3, 4, 6 to 8, 12 and 15 to 17 dependent thereon, is reversed.²

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 3, 4, 6 to 8, 12 and 15 to 17 under 35 U.S.C. § 103 is reversed.

REVERSED

Charles E. Frankfort
CHARLES E. FRANKFORT
Administrative Patent Judge

CHARLES E. FRANKFORT
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge


JENNIFER D. BAHR
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

)
)
)
) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES

² We have also reviewed the reference to Tebbe additionally applied in the rejection of claims 6 and 7 but find nothing therein which makes up for the deficiencies of Nelson and Koren discussed above.

Appeal No. 2005-0529
Application No. 09/579,901

Page 9

FRIEDRICH KUEFFNER
317 MADISON AVENUE
SUITE 910
NEW YORK, NY 10017

JVN/jg